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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,699	10/11/2001	Khaled Mahmud	97020CIP2CON2 (3600-091-0)	2387

7590 12/26/2002

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EXAMINER

THEXTON, MATTHEW

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/26/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

AS6

Office Action Summary	Application No. 09/975,699	Applicant(s) MAHMUD ET AL.	
	Examiner Matthew A Thexton	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-130 is/are pending in the application.
- 4a) Of the above claim(s) 82-94 and 118-130 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59-81 is/are allowed.
- 6) ☒ Claim(s) 95-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following papers have been received by the USPTO: Preliminary Amendment received October 11, 2001; IDS received October 11, 2001; Response to Restriction Requirement and Election of Species, received October 28, 2002.

Applicant has elected Group I, encompassing claims 59-81 and 95-117. Claims 82-94 and 118-130 have been withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 95-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 95 is independent and claims 96-117 depend therefrom. Claim 95 concludes with the phrase "wherein said aggregate has silanol groups located at the surface of the aggregate." This application is submitted as a Continuation of 09/453,419 and earlier applications. There does not appear to be any support for the noted phrase in the parent application, accordingly this constitutes New Matter and must be cancelled from the application. One does not know whether the silanol groups are organic or inorganic, or what conditions, steps, or techniques control their formation.

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2. Claims 95-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 95 is independent and claims 96-117 depend therefrom. Claim 95 concludes with the phrase "wherein said aggregate has silanol groups located at the surface of the aggregate." There is no description in the application regarding the noted phrase. There is no explanation to guide the public in how to make the invention as claimed. One does not know whether the silanol groups are organic or inorganic, or what conditions, steps, or techniques control their formation.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

3. Residence and Post Office Address for Inventor Yakov Kutsovsky is required.

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4. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. In particular, Claims 95-117 comprise aggregates "wherein said aggregate has silanol groups located at the surface of the aggregate" which subject matter is not present in the parent application to which the Declaration applies. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 09/453419, filed 2 December 1999, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-

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part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

If applicant does not overcome the new matter issue, applicant is required to re-designate the application as continuation-in-part.

Allowable Subject Matter

Claims 59-81 are allowed. These claims appear to be free of the prior art considered.

Abstract

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

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Extensive mechanical and design details of apparatus should not be given.

Specification

The disclosure is objected to because of the following:

1. page 6, lines 25-28, status of applications is not updated; ✓
2. page 6, the term "STEM-EDX" is not explained and not understood; ✓
3. page 11, line 24, applicant may not incorporate subject matter from foreign patents or non-patent literature, hence the phrase 'incorporated herein by reference' is misleading and must be removed; Y
4. page 12, lines 9-10, applicant may not incorporate subject matter from foreign patents, hence the phrase 'incorporated herein by reference' is misleading and must be removed; ✓
5. page 12 line 11, status of application is not updated; ✓
6. page 13, line 14, the acronym "CDBP" is not explained and not understood; ?
7. page 26, line 7, status of application is not updated; ✓
8. page 26, line 9, applicant may not incorporate subject matter from foreign patents, hence the phrase 'incorporated herein by reference' is misleading and must be removed; X
9. page 29, line 23, the term "N234 carbon black" is not explained and not understood; OK -
as per
disposition ✓
10. page 32, lines 5 and 6, the term "kscfh" is not explained and not understood; ✓

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11. page 38, lines 4 and 5, the term "nm3/h" is not explained and not understood; ✓

12. page 34, line 14, and page 40, line 14, the term "antioxident" is misspelled. ✓

Appropriate correction is required.

Citation of Pertinent Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kirkland et al. (US 4874518) teaches techniques for forming silanol groups on silica.

Pyle et al. (US 6458882) discloses the treatment of silica aggregates having silanol groups to render them more suitable as additives for rubber.

Information Disclosure Statement

The information disclosure statement filed 11 October 2002¹ fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. Non-English references have been lined through on the IDS. However, in some instances US equivalents were located and are included on the form 892.

Citations of abstracts listed on the IDS have been lined through but have been added to the form 892 under the category "Non-Patent Documents."

The citations of ISR or international search reports have been lined through because they are not art documents.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Friday, 8:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

MA. Thexton

Matthew A. Thexton
Primary Examiner
Art Unit 1714

mat
December 23, 2002